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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,774	03/03/2004	Kishiko Maruyama	500.43576X00/W4158-01EN	3222

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EXAMINER

TO, TUAN C

ART UNIT

PAPER NUMBER

3663

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/790,774	Applicant(s) MARUYAMA ET AL.	
	Examiner Tuan C. To	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, and 15-17 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the recitation "when traffic information which blocks the passage of the vehicle is received by the communication unit" renders the claim indefinite because it is unclear whether the traffic information occurs or not, and what if it does not occur.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 9, 11-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. (US 6169552B1) and in view of Shitamatsu et al. (US 20030216860A1).

Regarding claims 1, 3, and 9, Endo et al. direct to a navigation system comprising: a position detector for detecting a position of a vehicle (Endo et al., figure 2, GPS receiver 9), an input unit (5) used to input a user's request, a map summarizing unit (63) (Endo et al., figure 5), and a display unit (64) (Endo et al., figure 5).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

The statements of intended use or field of use, "for detecting...", "for receiving...", "for searching...", "for generating...", "for displaying...", "wherein..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re

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Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

The reference to Shitamatsu et al. directs to another navigation system, including a land mark search unit, which sets a parking lot (a land mark facility) within a zone, and which searches a route to that parking lot (Shitamatsu et al., page 1, paragraph 0007).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Endo et al. to include the teachings as taught by Shitamatsu et al. in order to display a recommended route from a current position to a selected parking lot, and therefore the driver gain advantage in quickly arriving to the parking lot in a specified zone.

With regard to claim 2, Shitamatsu et al. discloses a display unit that displays an attribute information about a land mark facility specified by an input unit (Shitamatsu et al., figure 1, paragraph 0026).

With regard to claim 11, the vehicle position as taught in Endo et al. is determined via the GPS receiver (9) and the vehicle position's mark is displayed in the road map (Endo et al., column 8, lines 47-59; column 16, lines 12-19).

With regard to claims 12, 13, and 16, as clearly shown in figure 28A, either the two-dimensional or three-dimensional display shows the road map are displayed as made linear and roads which meet at an intersection are displayed as made orthogonal to each other.

With regard to claims 15 and 17, Endo et al. further discloses display unit displays a road map, and the road map is a two-dimensional road map (Endo et al., figure 28A).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. (US 6169552B1), Shitamatsu et al. (US 20030216860A1) as applied to claims 1-3, 9, 11-13 and 15-17 above, and further in view of Hirota et al. (US 5568390A).

Neither Endo et al. nor Shitamatsu et al. discloses the following: "display unit displays the summary road map of all the other routes between the detected vehicle position and the specified target position or the specified departure position and the specified target position searched by said searching means by simplified broken lines".

The reference to Hirota et al. is directed to another navigation system for carrying out a route search and displaying the searched routes (Hirota et al., abstract) that have been shown in the display (24) (Hirota et al., figure 1). Furthermore, in figure 3, the reachable routes are shown by solid lines while the other routes are shown by broken lines (Hirota et al., column 7, lines 43-49).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Endo et al., and Shitamatsu et al. to include the teachings as taught by Hirota et al. to gain advantage thereof (i.e., a user is easily to recognize the boundary of the searched area retrieved from the desired input of a user; In addition, the user can be able to recognize the main road and recommended route located within a predetermined distance from the current vehicle position), as such results are in no more than conventionally known designs/techniques available within the prior art.

Claims 5, 6, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. (US 6169552B1), Shitamatsu et al. (US 20030216860A1) as applied to claims 1-3, 9, 11-13, and 15-17 above, and further in view of Hikita et al. (US 5892463A).

With regard to claim 5, Endo et al. and Shitamatsu et al. are both addressing the communication unit for receiving traffic information from a beacon transmitter. However, neither Endo et al. nor Sato et al. teaching "the display unit displays the traffic information received by the communication unit on the summary road map with respect to the corresponding route displayed thereon".

The reference to Hikita et al. has been provided to overcome the missing from Endo et al. and Shitamatsu et al. by teaching a mobile navigation system, wherein the

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traffic information receiving unit (13) (Hikita et al., figure 2) receiving the traffic information from a beacon transmitter installed along a road (Hikita et al., column 4, lines 1-13). The traffic information, such as traffic jam region or the traffic restriction region, are presented within the searched route (Hikita et al., column 6, lines 7-15) and that the route searched is displayed on the display unit (14) of the navigation system (Hikita et al., figure 2).

Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Endo et al., and Shitamatsu et al. to include the teachings as taught by Hikita et al. so that a vehicle user may change the current running plan to another by selecting another optimum route proximity to the current position of the vehicle. Therefore, the user can reach the destination on time as planned.

The statement of intended use or field of use, "for receiving..." clause is essentially method limitations or statement of intended or desired use. Thus, the claim as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

With regard to claims 6, 8, and 14, Hikita et al. disclose a detour route from a present position of the vehicle up to a target place is displayed (Hikita et al., column 9, lines 53-58).

The statement of intended use or field of use, "displays..." clause is essentially method limitations or statement of intended or desired use. Thus, the claim as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. (US 6169552B1), Shitamatsu et al. (US 20030216860A1) as applied to claims 1-3, 9, 11-13 and 15-17, and further in view of Sakamoto et al. (US 20030191585A1).

The combination of Endo et al. and Shitamatsu et al. directed to a navigation system as represented herein above, however, the combination does not disclose the following: "said predetermined range is broader than a display range of a magnified road map displayed for said main intersection".

Sakamoto et al. teach a navigation system, in which the map image M1, shown in figure 9, is within a predetermined range is broader than the display of map image M2 as shown in figure 10.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Endo et al, and Shitamatsu et al. to include the teachings as taught by Sakamoto et al. to gain advantage thereof (i.e., a vehicle user change a view mode from a general view to a view of details, therefore, a minor road or a location that previously be disappeared as now could be possibly retrieved for viewing), as such results are in no more than conventionally known designs/techniques available within the prior art.

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Response to Arguments

In response to the applicant's amendment filed on 01/20/2006, a new ground of rejection has been issued. The reference to Endo et al. and Sakamoto et al. are still applied in the rejection since they still read on the limitations of the claims. The new found reference to Shitamatsu et al. has been cited as teaching the missing features from Endo et al., and that the combination of Endo et al. and Shitamatsu et al. addresses at least the limitations as recited in the independent claims 1, 3, and 9.

Conclusions

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/tc

April 04, 2006


JACK KEITH
SUPERVISORY PATENT EXAMINER